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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/922,182	08/02/2001	Gregory Maurice Plow	STL920000035US1	7553
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ROGITZ & ASSOCIATES 750 B STREET SUITE 3120 SAN DIEGO, CA 92019			EXAMINER MYHRE, JAMES W	
			ART UNIT 3622	PAPER NUMBER
			MAIL DATE 08/08/2007	DELIVERY MODE PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No. 09/922,182	Applicant(s) FLOW ET AL.	
	Examiner James W. Myhre	Art Unit 3622	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 13 July 2007.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-4, 6-11 and 13-19 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-4, 6-11, and 13-19 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|------------------------------------------------------------------------------------------------------------|-----------------------------------------------------------------------------------------|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

1. This Office Action is in response to the Response to Office Action filed on July 13, 2007. Claims 1-4, 6-11, and 13-19 are currently pending and have been considered below.

EXAMINER'S NOTE

2. In Claims 7-11 and 13-19 the Applicant appears to be attempting to invoke 35 U.S.C. 112, 6th paragraph through the use of means-plus-function language, e.g. "logic mean for enabling a user to select a saved advertisement..." (Claim 7). The test of successful invocation of this paragraph comprises three prongs – (1) proper means-plus-function language in the claim; (2) no structural limitation in the claim; and (3) explicit structural limitations recited within the specification. While the language in these claims successfully passes the first prong of the three-prong test, it does not pass either of the other two prongs of the test. The claims themselves describe "logic means" as being part of a computer program, thus eliminating any kind of physical structure. Likewise, the specification describes the means for performing these functions as part of a computer program. Thus, no physical structure has been identified to which these functions could be attributed. Therefore, 35 U.S.C. 112, 6th paragraph has not been successfully invoked and the Examiner will consider the limitations to be any means by which the functions can be accomplished, e.g. computer program modules.

Claim Rejections - 35 USC § 102

3. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

4. Claims 1-4, 6-11, and 13-19 are rejected under 35 U.S.C. 102(b) as being anticipated by LeMole et al(6,009,410).

Claims 1, 7, 8, 14, and 18: LeMole discloses a system, computer readable medium, and method for storing Internet advertisements at a user computer, comprising:

- a. receiving automatically (pushed) a plurality of Internet advertisement at the user computer (column 6, lines 20-45);
- b. saving (storing) the plurality of advertisements on the user computer (column 6, lines 20-45);
- c. accessing the saved plurality of advertisements by the user on the display (i.e. advertising history window) of the user computer (column 5, lines 23-27;
- d. filtering previously displayed advertisements to determine eligible advertisements (column 5, lines 16-22);
- e. selecting one of the advertisement by the user (column 6, lines 63-66); and
- f. accessing the advertiser's website by clicking on a link within the advertisement (column 4, lines 29-35 and column 7, lines 12-35).

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Claims 2, 9, and 15: LeMole discloses a system, computer readable medium, and method as in Claims 1, 7, and 14 above, and further discloses the advertisement including an HTML tag (column 4, lines 29-35 and column 7, lines 12-35).

Claims 3, 10, and 16: LeMole discloses a system, computer readable medium, and method as in Claims 1, 8, and 14 above, and further discloses displaying the advertisement in response to toggling (clicking on) a button (Figure 2 and column 7, lines 12-35).

Claims 4, 11, and 17: LeMole discloses a system, computer readable medium, and method as in Claims 3, 10, and 16 above, and further discloses allowing the user to scroll through the advertisements (Figure 2 – top right corner of screen depicts the scroll bar that can be used to scroll through any data displayed in the window).

Claims 6, 13, and 19: LeMole discloses a system, computer readable medium, and method as in Claims 1, 8, and 14 above, and further discloses displaying and using Previous (Back) and Next (Forward) buttons to navigate through the saved advertisements or any other data/pages being displayed in the window (Figure 2 and column 6, line 63 – column 7, line 35).

Response to Arguments

5. Applicant's arguments with respect to claims 1, 4, 6, 7, and 13 have been fully considered but they are not persuasive.

a. The Applicant argues in reference to Claim 1 that LeMole does not disclose "an advertising history window displaying Internet content composed of plural advertisements" (paragraph 1), nor that the advertisements "are saved at the user computer" (paragraph 1). However, the Examiner notes that LeMole expressly discloses the user viewing "a composite HTML-formatted advertising page" and that "a plurality of different composite pages for the user...are each pushed over the Internet to the user's client terminal where each is cached for later retrieval".

b. The Applicant also argues in reference to Claim 1 that LeMole does not disclose "the limitation of allowing a user to filter previously displayed advertisements" (paragraph 2). However, the Examiner notes that LeMole discloses that the advertisements will be filtered (selected) based on the user data which the user had entered when registering with the system, i.e. the advertisements are being filtered by the user.

c. The Applicant argues in reference to Claim 4 that LeMole does not disclose allowing the "user to scroll through the saved advertisements" (paragraph 3). However, as noted in the rejection above, LeMole discloses a scroll bar on the display window and further discloses the window containing a plurality of previously viewed advertisements (advertising history window). Thus, it is inherent that the scroll bar

would be used to scroll through any data, including advertisements, being displayed within the window.

d. The Applicant argues in reference to Claim 6 that LeMole does not disclose “using back and forward buttons to navigate through the saved advertisements” (paragraph 4). However, as noted in the rejection above, LeMole discloses Back and Forward buttons for navigating through the data being displayed on the display window and further discloses the window containing a plurality of previously viewed advertisements (advertising history window). Thus, it is inherent that the Back and Forward buttons would be used to navigate between the advertisements and between the different composite advertising windows discussed by LeMole.

e. The Applicant argues in reference to Claim 7 that LeMole does not disclose that “the server transmit the Internet advertisements to the user computer while the user is engaged in activity other than requesting the advertisements” (paragraph 5). The Examiner notes that LeMole discloses that the advertisements are automatically “pushed” to the user’s computer before the user enters the commercial mode. Thus, the server is transmitting the advertisements to the user computer while the user is not actively requesting the advertisements.

f. The Applicant argues in reference to Claim 13 that the above argues also apply (“*mutatis mutandis*”)(paragraph 6). The Examiner notes that the above responses to the Applicant’s arguments also apply to Claim 13.

g. Finally, the Applicant argues that Claims 7-11 and 13-19 invoke 35 U.S.C. 6th paragraph by citing specific structure in the specification for each of the means-plus-

function limitations in the claims (paragraph 7). However, the Applicant has failed to point out any specific structures within the specification that define any of the mean-plus-function limitations. "Logic means", i.e. computer programming code, is not a physical structure, contrary to the Applicant's arguments. In fact, in Claim 7 it is expressly recited that "the program further comprises:" the logic means. Thus, even in the claims the Applicant has admitted that the means are not physical structures, but merely computer programming code.

Conclusion

6. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to James W. Myhre whose telephone number is (571) 272-6722. The examiner can normally be reached on Monday through Thursday 6:00-3:00.


If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Eric Stamber can be reached on (571) 272-6724. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.



JWM

August 3, 2007



James w. Myhre
Primary Patent Examiner